



PATENTS
ODS-9

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants : Connie T. Marshall et al.
Application No. : 09/609,073 Confirmation No. : 2964
Filed : June 30, 2000
For : INTERACTIVE WAGERING SYSTEMS AND METHODS
FOR RECORDING WAGERING EVENTS
Art Unit : 3714
Examiner : William H. McCulloch Jr.

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Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Sir:

Appellants are filing this Appeal Brief in support of their appeal from the rejection of claims 2-19 and 38-48 in the Office Action dated January 29, 2007 (hereinafter "Office Action"). A Notice of Appeal is being filed concurrently herewith.

Appellants request that the Notice of Appeal fee required under 37 C.F.R. § 41.20(b)(1) and the brief filing fee required under 37 C.F.R. § 41.20(b)(2) that were already paid from the previous appeal be applied to this new appeal. Appellants note that the Notice of Appeal fee under 37 C.F.R. § 41.20(b)(1) has increased from \$330.00 to \$500.00 after the filing of the previous Notice of Appeal. Accordingly, the Director is hereby authorized to charge the difference of \$170.00 to Deposit Account No. 06-1075

(Order No. 003043-0009). The Director is also hereby authorized to charge any additional fees that may be due in connection with this Appeal Brief, or credit any overpayment of the same, to Deposit Account No. 06-1075 (Order No. 003043-0009). A separate Authorization to Charge Deposit Account is enclosed for these purposes (in duplicate).

In view of the arguments and authorities set forth below, the Board should find the rejection of claims 2-19 and 38-48 to be in error, and the Board should reverse the rejection.

This Brief has the following appendices:

Claims Appendix

Appendix A: Copy of claims 2-19 and 38-48
involved in this appeal;

Evidence Appendices

Appendix B: Copy of the Office Action dated
January 29, 2007;

Appendix C: Copy of the July 19, 2006 Amended
Appeal Brief (appendices omitted);

Appendix D: Copy of Brenner et al., U.S.
Patent No. 5,830,068 (entered in
the record by the Examiner in the
Office Action dated August 27,
2001 and initialed by the Examiner
in the Information Disclosure
Statement on August 17, 2001);

Appendix E: Copy of Brenner et al., U.S.
Patent No. 6,004,211 (entered in
the record by the Examiner in the

Office Action dated March 21,
2002).

Related Proceedings Appendix

None.

(i) Real Party in Interest

Appellants respectfully advise the Board that the real party in interest in the above-identified patent application is ODS Properties, Inc., a corporation organized and existing under the laws of the State of Delaware, and having an office and place of business at 6701 Center Drive West, Los Angeles, CA 90045, which is the assignee of this application.

(ii) Related Appeals and Interferences

Appellants respectfully advise the Board that there are no other appeals or interferences known to appellants, their legal representative, or their assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(iii) Status of Claims

Claims 2-19 and 38-48 are rejected in this application and are on appeal. Claims 1, 20-37 and 49-56 have been cancelled.

(iv) Status of Amendments

Appellants' Reply to Final Office Action dated July 12, 2004 cancelled independent claims 1 and 37 without prejudice. Claims 2-18 and 38-47 were previously dependent on claims 1 and 37, respectively. Pursuant to 37 C.F.R. § 1.116, claims 2, 4, 11, 14-18, 38 and 43-46 were amended

such that claims 2-18 and 38-47 would be dependent on independent claims 19 and 48, respectively. For purposes of Appeal, these amendments were entered in the Advisory Action dated August 12, 2004.

(v) Summary of Claimed Subject Matter

Appellants' invention, as defined by independent claims 19 and 48, generally relates to a system and method for allowing users to wager on and record wagering events (see, e.g., appellants' specification, page 29, line 31 to page 30, line 9 and page 35, line 31 to page 36, line 16). A user is allowed to create and place a wager for a given race (see, e.g., appellants' specification, page 38, line 18 to page 41, line 26; see also, e.g., appellants' drawings, FIGS. 8-14). The user is automatically provided with an opportunity to record the given race in response to the user placing the wager for a given race (see, e.g., appellants' specification, page 41, lines 18-26; see also, e.g., appellants' drawings, FIG. 14). The given race is recorded (see, e.g., appellants' specification, page 41, line 27 to page 42, line 11 and page 43, line 30 to page 44, line 3; see also, e.g., appellants' drawings, FIG. 15).

(vi) Grounds of Rejection to be Reviewed on Appeal

The following grounds of rejection are to be reviewed on this appeal:

(a) claims 2-9, 11-19, and 38-48 stand rejected under 35 U.S.C. § 102(a)¹ as being anticipated by Brenner

¹ Although the Office Action rejection was under 35 U.S.C. § 102(e), appellants submit that the rejection should be under 35 U.S.C. § 102(a) because Brenner '068 was patented on November 3, 1998, before appellant's earliest effective filing date. Appellants will refer to this rejection as a rejection under 35 U.S.C. § 102(a) for the purposes of this Appeal Brief.

U.S. Patent No. 5,830,068 (hereinafter "Brenner '068");

(b) claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Brenner '068;

(c) claims 2-19 and 38-48 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 17, 37-41, 46, and 49 of Brenner et al. U.S. Patent No. 6,004,211 (hereinafter "Brenner '211"); and

(d) claims 11, 14, 15, 38, 43, and 44 (as well as claims 13 and 39-42 through their dependency) stand rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement.

(vii) Argument

A. Reopening Prosecution Is Improper and Unduly Delays the Issuance of the Patent

The Examiner in the February 11, 2004 final Office Action rejected claims 1-19 and 37-48 under 35 U.S.C. § 103(a) over the combination of Brenner '068, HFDG, and Lawler. In response to this final rejection, appellants filed an Appeal Brief on March 11, 2005² setting forth arguments over this rejection. The Examiner, in response to appellants' Appeal Brief, reopened prosecution and issued a new non-final Office Action on January 29, 2007. The Examiner provided three reasons for reopening prosecution: 1) a "newly applied interpretation of claimed subject matter"; 2) "new grounds of rejection";

² Appellants also filed an amended Appeal Brief on July 19, 2006 correcting the format of the March 11, 2005 Appeal Brief.

and 3) "an earnest endeavor to further clarify the record" (Office Action, page 2).

While the Examiner issued the new non-final Office Action in an attempt to clarify the record, the status of the previous § 103(a) rejection is now unclear. In the new Office Action, the Examiner disagreed with appellants' arguments in the Appeal Brief over the § 103(a) rejection, calling them "not persuasive" (Office Action, page 11). If the Examiner found appellants' arguments in the Amended Appeal Brief "not persuasive," then the Examiner should have filed an Examiner's Answer, with or without a new ground of rejection, in order to further clarify the record. See MPEP § 1207.03.

Instead, the Examiner has reopened prosecution and unduly delayed the issuance of the patent. The Examiner is required to perform a thorough search of all the available prior art and put forth his best rejection during the prosecution process in the first Office Action. See generally 35 U.S.C. §§ 131, 132. According to the MPEP, this rejection should be made using the "best available art." See MPEP § 706.02(I). The Examiner's new ground of rejection is based solely on Brenner '068, which was used by the Examiner in the previous § 103(a) rejection. Therefore, because this art was known to the Examiner, this rejection should have been made earlier.

Almost two years have passed since appellants first filed for appeal, and over six and a half years have passed since appellants filed the instant application. Appellants want to exercise their statutory right to have their application reviewed by the Board without any further undue delay.

While the Examiner appears to believe that the previous § 103(a) rejection is still a proper rejection of appellants' claims, the § 103(a) rejection was not included in the present Office Action. Further, neither the Examiner's allegedly new interpretation of the claims nor the Examiner's alleged clarification suggests that the prior § 103(a) rejection is no longer proper. Accordingly, it is unclear whether this rejection still applies to the pending claims.

Appellants request that the Examiner state in the next communication whether he believes the previous § 103(a) rejection over Brenner '068, HFDG, and Lawler is still proper. Because no statements in the current Office Action suggest that the previous § 103(a) rejection should be withdrawn, appellants refer the Board to appellants' previous arguments made in the July 19, 2006 Amended Appeal Brief (attached in Appendix C) over the § 103(a) rejection. Appellants have set forth new arguments below addressing the Examiner's new ground of rejection.

B. The 35 U.S.C. § 102(a) Rejection

i. Claims 3-7, 9, 11-19, and 38-48

In the Office Action, the Examiner rejected independent claims 19 and 48 under 35 U.S.C. § 102(a) as being anticipated by Brenner '068. Appellants respectfully traverse this rejection and request that it be overturned at least because Brenner '068 fails to show or suggest automatically providing a user with an opportunity to record a given race in response to placing a wager on the given race, as recited by each of independent claims 19 and 48.

Brenner '068 describes an interactive wagering system that allows users to create and place wagers by interacting with an interactive wager-creation interface (see Brenner '068, e.g., FIGS. 36-39 and 41-44). Brenner '068 also shows that a selectable "Tape/VCR" menu option associated with a given race may be presented to a user in response to a user selecting a menu option labeled "Other Races." After selecting this menu option, the user may select a "Tape/VCR" menu option to record the race (see Brenner '068, column 28, lines 4-23 and FIG. 49).

On page 2 of the Office Action, the Examiner allegedly advances a new interpretation of appellants' independent claims 19 and 48. The Examiner interprets appellants' claimed feature of "automatically providing the user with an opportunity to record the given race in response to the user placing the wager for the given race" as "automatically (without additional effort) providing an opportunity (favorable situation or condition) to record a race in response to (after) placing a wager." *Id.* Relying on this interpretation of appellants' claimed feature, the Examiner contends that appellants' independent claims are anticipated by Brenner '068. See Office Action, pages 6-7. Appellants respectfully disagree.

The Examiner seems to argue that Brenner '068 meets appellants' claimed feature above because a user of Brenner's system is permitted to select the menu option "Other Races" from the main wagering screen and then "Tape/VCR" to program a video reorder to record a race (see Office Action, page 7). According to the Examiner, through these two menu options, "the user *automatically* has the *opportunity* to record the wagered upon race" (Office Action, page 7, emphasis in original).

As previously argued in the July 19, 2006 Amended Appeal Brief (see Appendix C), none of the references cited by the Examiner, alone or in combination, show or suggest automatically providing a user with an opportunity to record a given race in response to placing a wager on that race. It is clear from Brenner's flowcharts in FIGS. 31, 32, and 34 that in order for a race to be recorded after placing a wager, a user of Brenner's system must first select the "Other Races" menu option (FIG. 32) and then select the "Tape/VCR" menu option (FIG. 34). No opportunity to record a race is automatically provided to a user in response to placing a wager in Brenner '068; rather, the user must manually select the "Other Races" menu option to be presented with an opportunity to record a race.

The Examiner states that the term automatically means "without any additional effort." See Office Action, page 2. However, the Examiner concedes that a user in Brenner '068 must select the "Other Races" menu option in order to be presented with the "Tape/VCR" menu option, which allows a user to record a race. See Office Action, page 7. Selecting the "Other Races" menu option is certainly additional effort and this contradicts the Examiner's own definition of "automatically." It also contradicts the Examiner's contention that Brenner's system automatically provides the user an opportunity to record a race in response to placing a wager on that race.

In contrast to appellants' claimed invention, a user of Brenner's system must actively seek out an opportunity to record a race. No opportunity to record a race is automatically presented, particularly not in response to placing a wager on that race. Rather, in

response to placing a wager in Brenner '068, confirmation display screen 506 (FIG. 40) is displayed to the user with wager confirmation message 504. From display screen 506, there is no opportunity for a user to record a wager or even access the "Other Races" menu option. According to the flow chart in FIG. 31, the user is then returned to the main wagering screen (e.g., FIG. 37). From this screen, in order to record a race, the user must manually select the "Other Races" menu option to be presented with the "Tape/VCR" menu option. Only appellants' novel approach automatically provides a user with an opportunity to record a race in response to placing a wager on the race, as recited by independent claims 19 and 48.

For this reason alone, appellants respectfully request that the Board reverse the Examiner's rejection of independent claims 19 and 48 under 35 U.S.C. § 102(e). The rejection of dependent claims 3-7, 9-18, and 38-47, which include all the limitations of their respective independent claim, should be reversed for at least the same reason.

ii. Claim 2

Dependent claim 2 is not anticipated by Brenner '068 for at least one additional, independent reason. This claim recites the additional step of allowing the user to select "yes or no" in response to the option to record the given race. In the Office Action, the Examiner contends that Brenner '068 anticipates this additional step by allowing a user to select the "Tape/VCR" menu option (e.g., from display screen 598 of FIG. 49). According to the Examiner, "selecting 'no' is anticipated by a user of

Brenner '068 pressing any other button and/or not pressing "Tape/VCR" (Office Action, pages 7-8).

Appellants respectfully disagree. Nowhere in Brenner '058 does the system allow a user to select "yes" or "no" in response to an option to record a race. Failing to select an option or selecting any other option is not equivalent to allowing a user to select "no," and selecting a "Tape/VCR" option is not equivalent to allowing the user to select "yes." Rather, Brenner '068 does not show this novel feature. For at least this additional, independent reason, appellants submit that dependent claim 2 is allowable over Brenner '068. The rejection of this claim should therefore be overturned.

iii. Claim 8

Dependent claim 8 is also not anticipated by Brenner '068 for at least one additional, independent reason. This claim recites that previously recorded races are stored in a personal archive, and the races are listed with their corresponding track name. The Examiner contends that Brenner '068 "teaches listing previously recorded races in the personal archive with their corresponding track name and race number." To support this contention, the Examiner points to FIGS. 49 and 50 of Brenner '068. Appellants respectfully disagree.

Contrary to the Examiner's contention, FIGS. 49 and 50 of Brenner '068 do not list previously recorded races in a personal archive, particularly not with their corresponding track name. Rather, these figures show illustrative menu options, such as "Results" and "Tape/VCR." As already described, the "Tape/VCR" option programs a video recorder to record a race. Selecting

"Results" allows a user to order an earlier race. See Brenner '068, column 26, line 65 - column 27, line 22. For example, after selecting "Results," the user may be presented with the display screen of FIG. 50, which allows the user to purchase a video of a race. *Id.* However, none of the listings in FIGS. 49 or 50 refer to previously recorded races in a user's personal archive. Rather, these figures enable users to set a recording or order a video of a race. See Brenner '068, column 27, lines 22-38. For at least this additional, independent reason, appellants submit that dependent claim 8 is allowable over Brenner '068. The rejection of this claim should therefore be overturned.

C. The 35 U.S.C. § 103(a) Rejection of Claim 10

The Office Action rejected claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Brenner '068. The Office Action concedes that Brenner '068 fails to disclose that the previously recorded races in the personal archive are listed with their corresponding date. Nevertheless, the Examiner contends that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to list the previously recorded videos in a personal archive with the videos' corresponding dates. See Office Action, page 10. Appellants respectfully disagree.

The Examiner merely submits that it would have been obvious to list the previously recorded videos with their corresponding dates "in order to allow users to correctly identify when the race took place." *Id.* Appellants submit that this motivation is far from the "objective teaching" required to sustain a rejection under

35 U.S.C. § 103. See *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). "Broad conclusory statements," such as the Office Action's purported motivation above, "standing alone, are not 'evidence'" of a motivation to modify the teachings of a reference. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999), abrogated on other grounds by *In re Gartside*, 53 U.S.P.Q.2d 1769 (Fed. Cir. 2000). Nothing in Brenner '068 suggests that previously recorded races in a user's personal archive should be listed with their corresponding date. Therefore, appellants submit that the Examiner has failed to establish a *prima facie* case of obviousness.

For at least this additional, independent reason, appellants submit that dependent claim 10 is allowable over Brenner '068. The rejection of this claim should therefore be overturned.

D. The Double Patenting Rejection
Of Claims 2-19 and 38-48

Claims 2-19 and 38-48 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 17, 37-41, 46, and 49 of Brenner '211. Appellants respectfully submit that the obviousness-type double patenting rejection is improper and should be overturned.

The Examiner has ignored appellants' citations to case law in the previous Appeal Brief that states that obviousness-type double patenting rejections should be used for references that are not available as prior art under 35 U.S.C. § 102 or 103. See Amended Appeal Brief § (vii)(B), attached as Appendix C, citing *In re Boylan*, 392 F.2d 1017, 1018 (C.C.P.A. 1968), *In re Braithwaite*, 379 F.2d 594, 600, n.4 (C.C.P.A. 1967), *Eli Lilly & Co. v. Barr Labs.*, 251

F.3d 955, 966 (Fed. Cir. 2001), *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1278 (Fed. Cir. 1992). The Examiner maintains that the obviousness-type double patenting rejection is proper. To support his position, the Examiner cites to MPEP § 804 and Chart II-B. See Office Action, page 11. Appellants still respectfully disagree.

The MPEP states that "[a] double patenting rejection of the obviousness-type . . . is 'analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. § 103' except that the patent principally underlying the double patenting rejection is not considered prior art." MPEP § 804(B)(I) (citing *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967)). Thus, it is clear that when a reference, such as Brenner '211, is available as prior art, the proper rejection is one under 35 U.S.C. § 102 or 103 and not an obviousness-type double patenting rejection.

Appellants also note that although Chart II-B and MPEP § 804.03(IV) do refer to some instances where both a double-patenting rejection and a prior art rejection may be made, these are preliminary instances where the Examiner cannot resolve the ownership of the application and the ownership of the reference with conflicting claims. However, once ownership has been resolved, only one of these rejections should be maintained. This application is currently commonly owned with Brenner '211 and was commonly owned with Brenner '211 at the time of appellants' invention. Appellants note that Brenner '211 is a continuation of Brenner '068 and is available as 35 U.S.C. § 102(e) prior art. Therefore, the only proper rejection is one under 35 U.S.C. § 102.

Regardless of whether the obviousness-type double patenting rejection is found to be proper, appellants submit that claims 2-19 and 38-48 are not obvious in view of any issued claims in Brenner '211. Namely, appellants' pending claims are patentably distinct from the claims of Brenner '211 at least because they require automatically providing the user with an opportunity to record a given race in response to the user placing the wager for the given race.

For the reasons set forth above, appellants respectfully request that the Board overturn the obviousness-type double patenting rejection of claims 2-19 and 38-48.

E. The 35 U.S.C. § 112 Rejection

The Office Action also rejected claims 11, 14, 15, 38, 43, and 44 (as well as claims 13 and 39-42 through their dependency) under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement. More specifically, the Office Action contends that defining the term "user equipment" as user television equipment, user computer equipment, and user telephone equipment in dependent claims 11, 14, 15, 38, 43, and 44 contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. See Office Action, page 3.

The Examiner further contends that appellants' specification, at best, supports claims reciting that the user equipment comprises user telephone equipment, user television equipment, or user computer equipment, not claims reciting that the user equipment is one of these types of user equipment. According to the Examiner, user

telephone, computer, or television equipment "alone is not adequately enabled to perform the functions set forth in claims 19 and 48" (Office Action, page 3). Appellants respectfully disagree.

Appellants' FIG. 1 shows three illustrative types of user equipment including user telephone equipment 32, user computer equipment 20, and user television equipment 22. Appellants' specification teaches that "[s]ystem 10 may be used to provide an interactive wagering service to users of various user equipment." (Specification, page 8, lines 14-16). Illustrative user television equipment, user computer equipment, and user telephone equipment are shown in more detail in FIGS. 2-5. A generalized schematic diagram of user equipment (e.g., any one of user television equipment, user computer equipment, or user telephone equipment) is shown in FIG. 6.


Regardless of the type of user equipment, appellants' specification teaches that an "interactive wagering application may run locally on the user equipment (e.g., on a set-top box, personal computer, cellular telephone, handheld computing device, etc.) or may run using a client-server or distributed architecture where some of the application is implemented locally on the user equipment and some of the application is implemented at a remote location . . . " (Specification, page 8, lines 16-27). From this description and the depiction of the generalized user equipment in FIG. 6, it is clear that the interactive wagering application may be implemented at least in part locally on any one of user telephone equipment 32, user computer equipment 20, and user television equipment 22. Any one of these three types of user equipment may place wagers and perform all related

functionality (e.g., automatically provide a user with an opportunity to record racing videos) via the wagering application. No other user equipment is required. Of course, other systems may be used (e.g., transaction processing and subscription management system 24) to complete the wager, but these systems are not considered as part of the user equipment, as shown in appellants' FIG. 1. As such, appellants submit that a user at one or more of user telephone equipment 32, user computer equipment 20, and user television equipment 22 may interactively place wagers on races with an interactive wagering application implemented using the user equipment, as recited by independent claims 19 and 48. The dependent claims further specifying the user equipment as either user computer equipment, user telephone equipment, or user television equipment are therefore each separately fully enabled by the specification.

For at least the foregoing reason, appellants request that the rejection of claims 11, 14, 15, 38, 43, and 44 (as well as claims 13 and 39-42 through their dependency) under 35 U.S.C. § 112, first paragraph, be overturned.

For the reasons set forth above, appellants respectfully submit that claims 2-19 and 38-48 are in condition for allowance. The Examiner's rejections of these claims should be reversed.

Respectfully submitted,



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(viii) Claims Appendix

CLAIMS APPENDIX A
CLAIMS ON APPEAL

2. The method defined in claim 19 further comprising allowing the user to select yes or no in response to the option to record the given race.

3. The method defined in claim 2 wherein the given race is recorded in response to the user selecting yes to the option to record the given race.

4. The method defined in claim 19 wherein the given race is recorded in a personal archive.

5. The method defined in claim 4 wherein the personal archive is located at the user equipment.

6. The method defined in claim 4 wherein the personal archive is located remote from the user equipment.

7. The method defined in claim 4 further comprising using the interactive wagering application to allow the user to access the personal archive and view previously recorded races.

8. The method defined in claim 7 wherein the previously recorded races in the personal archive are listed with their corresponding track name.

9. The method defined in claim 7 wherein the previously recorded races in the personal archive are listed with their corresponding race number.

10. The method defined in claim 7 wherein the previously recorded races in the personal archive are listed with their corresponding date.

11. The method defined in claim 19 wherein the user equipment is user television equipment.

12. The method defined in claim 11 wherein the given race is recorded with a videocassette recorder.

13. The method defined in claim 11 wherein the given race is recorded with a digital video recorder.

14. The method defined in claim 19 wherein the user equipment is user computer equipment.

15. The method defined in claim 19 wherein the user equipment is user telephone equipment.

16. The method defined in claim 19 wherein the given race is recorded in real-time.

17. The method defined in claim 19 wherein the given race is recorded after the race has taken place.

18. The method defined in claim 19 wherein the user is charged a fee for recording the given race.

19. A method for a user at user equipment to interactively wager on races with an interactive wagering application implemented using the user equipment, comprising:

allowing the user to create and place a wager for a given race;

automatically providing the user with an opportunity to record the given race in response to the user placing the wager for the given race; and

recording the given race.

38. The interactive wagering system defined in claim 48 wherein the user equipment is user television equipment.

39. The interactive wagering system defined in claim 38 wherein the control circuitry is located within a set-top box.

40. The interactive wagering system defined in claim 38 wherein the display device is a television.

41. The interactive wagering system defined in claim 38 wherein the recording device is a videocassette recorder.

42. The interactive wagering system defined in claim 38 wherein the recording device is a digital video recorder.

43. The interactive wagering system defined in claim 48 wherein the user equipment is user computer equipment.

44. The interactive wagering system defined in claim 48 wherein the user equipment is user telephone equipment.

45. The interactive wagering system defined in claim 48 wherein the recording device is located remote from the user equipment.

46. The interactive wagering system defined in claim 48 wherein the given race is recorded in a personal archive.

47. The interactive wagering system defined in claim 46 wherein the control circuitry is further configured to allow the user to access the recording device and view previously recorded races.

48. An interactive wagering system in which an interactive wagering application is implemented on user equipment that provides a user with an opportunity to place wagers on races to be run, comprising:

control circuitry configured to allow the user to create and place a wager for a given race, wherein the user is automatically provided with an opportunity to record the given race in response to the user placing the wager for the given race; and

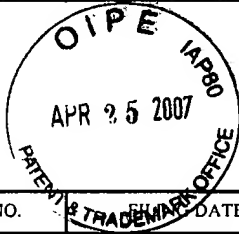
a recording device that records the given race.

(ix) Evidence Appendix

EVIDENCE APPENDIX B
COPY OF THE OFFICE ACTION DATED JANUARY 29, 2007



UNITED STATES PATENT AND TRADEMARK OFFICE



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	EXAMINATION DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,073	06/30/2000	CONNIE T MARSHALL	ODS-9	2964

1473 7590 01/29/2007
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EXAMINER

MCCULLOCH JR, WILLIAM H

ART UNIT	PAPER NUMBER
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3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

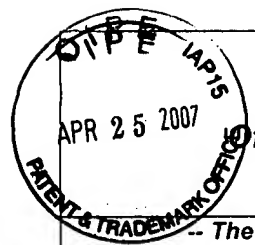
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Act
Date
By

ODS/009
3 Months
Apr 29 2007
AOK

ROPES & GRAY LLP, PATENT DEPT.
REFERRED TO
NOTED BY



Office Action Summary

Application No.	Applicant(s)	
09/609,073	MARSHALL ET AL.	
Examiner	Art Unit	
William H. McCulloch Jr.	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-19 and 38-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-19 and 38-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to an appeal brief filed 7/19/2006. In view of the newly applied interpretation of claimed subject matter, new grounds of rejection, and an earnest endeavor to further clarify the record, prosecution is hereby reopened.

Claim Interpretation

2. Claim 19 is directed in pertinent part toward 1) allowing a user to create and place a wager for a given race; 2) automatically providing the user with an opportunity to record the given race in response to the user placing the wager for the given race; and 3) recording the given race. The term "opportunity" is defined as a situation or condition favorable for attainment of a goal (Random House Unabridged Dictionary). Therefore, automatically providing an opportunity to record a race in response to placing a wager, as stated in (2) above, is interpreted as automatically (without additional effort) providing an opportunity (favorable situation or condition) to record a race in response to (after) placing a wager. An analogous interpretation is applied to claim 48. As described below, such features are anticipated by the prior art.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 11, 14, 15, 38, and 43-44 (with claims 13 and 39-42 by dependency) are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the

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specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 11, 14, 15, 38 and 43-44 describe "user equipment" as is recited in independent claims 19 and 48. Claims 19 and 48 are directed in pertinent part toward implementing an interactive wagering application on "user equipment". It is clear from the specification (see at least the Summary of the Invention) that the "user equipment" is made up of various devices such as telephone equipment and television equipment. However, it is also clear from the specification that such equipment must work together to produce the system described in independent claims 19 and 48. As such, claims 11, 14, 15, 38, and 43-44 are not enabled by the specification because such claims require that "user equipment" is an individual element, such as user telephone equipment (claims 15 and 44). At best, the specification supports a claim that user equipment comprises user telephone equipment, because user telephone equipment alone is not adequately enabled to perform the functions set forth in claims 19 and 48. Similar logic applies to the other above-rejected claims. Applicant is required to provide an appropriate correction to the claims. For the purposes of this examination, the examiner will interpret claims 11, 14, 15, 38, and 43-44 as reciting, "user equipment comprises" X, where X is user television equipment, user computer equipment, or user telephone equipment, depending upon the content of a given claim. Claims 13 and 39-42 depend from the above-rejected claims and are thus also rejected under 35 U.S.C. 112.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 2-7, 11-19, 38, and 39-48 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5, 17, 37-41, 46 and 49 of U.S. Patent No. 6,004,211 to Brenner et al. (hereinafter Brenner '211).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of Brenner '211 fully encompass the instant claims, as shown in view of the interpretation set forth above.

7. Claim 39 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 37 of Brenner '211. Brenner '211 teaches a user terminal configured to perform the functions necessary for operation (e.g. the user terminal contains the "control circuitry" as described in instant claim 39). Brenner '211 lacks describing that the user terminal is a set-top box. A set-top box, as described in the context of the claims, is merely a device dimensioned to be capable of sitting on top

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of a monitor. Such a limitation changes the size of the device, but does not affect the way in which the device operates. As such, instant claim 39 is not patentably from claim 37 of Brenner '211. See *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). (The Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.) Therefore, it would have been an obvious matter of choice, well within the capabilities of one of ordinary skill in the art at the time of invention to embody the control circuitry of Brenner '211 in a set-top box in order to minimize the size of the device so as to allow the device to sit atop a monitor (the monitor being required by Brenner '211 to operate).

8. Claims 8-10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, and 5 of Brenner '211. Claims 1, 4, and 5 of Brenner '211 allow, in pertinent part, a user to select and view video clips of particular races using a user terminal. Brenner '211 lacks in describing that the recorded races are listed with corresponding track names, race numbers, or dates. However, it is clear from the claims of Brenner '211 that a user must be able to discern an individual race from a plurality of previously recorded races and input a request to view said race. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to list recorded races with their corresponding track names, race

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numbers, and/or dates in order to allow a user of the system to identify and select a particular race as is required by the claimed system of Brenner '211.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10. Claims 2-9, 11-19, and 38-48 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 5,830,068 to Brenner et al. (hereinafter Brenner '068).

Regarding claims 19 and 48, Brenner '068 teaches a method and system for a user at user equipment to interactively wager on races with an interactive wagering application implemented using the user equipment (see at least abstract, figs. 1, 2, 29, 30, and cols. 2-5). Brenner '068 further teaches a system and method step of allowing the user to create and place a wager for a given race (see at least abstract, figs. 3-7, 15, 31-34, 36-44, 46, 48-50, and cols. 2-5). Brenner '068 additionally teaches a system

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and method step of recording the given race (see at least figs. 30, 34, 49 and cols. 3:11-14, 4:65-5:3, and 27:65-28:15).

Further regarding claims 19 and 48, Brenner '068 teaches a system and method step of automatically providing the user with an opportunity to record the wagered upon race in response to the user placing the wager for the given race. Figure 31 shows a flow chart for placing a wager on a particular race, with figures 36-39 showing user interfaces for placing the wager. Box 486 of figure 31 shows the "Place Wager" selection, which instructs the system to Place Wager operation 510, and then returns to box 486. Therefore, Brenner '068 teaches a system and method step of allowing a user to create a wager for a given race. Box 486 is represented by the user interface of figure 39. The flow charts of figures 31, 32, and 34 (explained in cols. 23-28) and the user interfaces of figures 48-49 show that in response to placing the wager, the user *automatically* has the *opportunity* to record the wagered upon race by selecting menu choices "Other Race" and "Tape/VCR" to program a video recorder to record the race (see at least cols. 27:65-28:15). Therefore, in Brenner '068 the opportunity to record the race is provided automatically and in response to placing a wager.

Regarding claims 2 and 3, Brenner '068 states, "If 'tape/VCR' is selected at step 596 (FIG. 34), at step 606 (FIG. 34) user terminal 370 (FIG. 30) programs video recorder 424 (FIG. 30) with the appropriate recording information or actuates video recorder 424 (FIG. 30) at the time of the selected race. Thus, selecting 'tape/VCR' allows the selected race to be recorded" (col. 28:5-11). Therefore, selecting "yes" is anticipated by a user of Brenner '068 pressing "Tape/VCR" to actuate recording,

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whereas selecting "no" is anticipated by a user of Brenner '068 pressing any other button and/or not pressing "Tape/VCR".

Regarding claims 11, 38, and 40, Brenner '068 teaches that the user equipment is user television equipment, for example in the form of a "conventional television monitor" (col. 3:59-60).

Regarding claims 12 and 41, Brenner '068 teaches that a recording device may be a "conventional video cassette recorder" (col. 21:56-58).

Regarding claims 13 and 42, Brenner '068 teaches recording a given race with a digital video recorder indicated by the digitally-compressed video signals being processed, encoded, decoded, and transmitted by the video and data distribution system 368 and/or the user terminal 370 (see at least 27:46-64). The digital video recorder is further indicated by the recitation of a high capacity storage medium, suitable for recording races as they are received from racing video source 374, embodied in video and data distribution system 368 (see at least 27:39-45).

Regarding claims 14 and 43, Brenner '068 describes employing user computer equipment in the form of user terminal 122, which is described as being "preferably microprocessor-based [and] supports software capable of coordinating the receipt and display of racing data and the placing of wagers electronically" (col. 7:21-24). See also fig. 1 and col. 7:24-34.

Regarding claims 15 and 44, Brenner '068 teaches that user equipment is telephone equipment used to implement the interactive wagering application (see at least 7:35-54, 8:29-40).

Regarding claim 16, Brenner '068 teaches recording a race in real-time (see at least col. 6:55-62 and 17:65-18:40).

Regarding claims 17 and 47, Brenner '068 describes recording the race after it has taken place (see at least cols. 26:65-27:22).

Regarding claim 18, Brenner '068 teaches charging a fee for recording a given race (see at least col. 27:33-39).

Regarding claim 39, Brenner '068 discloses using a set-top box 434 disposed between display and processing circuitry 416 and monitor 378 (see at least fig. 30 and 22:13-15). Therefore, Brenner '068 teaches a set-top box wherein control circuitry is located, wherein the control circuitry is configured to allow the user to create and place a wager for a given race.

Regarding claims 6 and 45, Brenner '068 teaches a recording device located remote from the user equipment (see at least 7:4-20, 17:48-18:14, 21:63-22:12, and 27:23-29).

Regarding claims 4, 5, 7, and 46, as described above, Brenner '068 teaches recording racing videos on a videocassette, which is interpreted as a personal archive. Further support for the interpretation is found in above-cited sections of Brenner '068 regarding the user's own home equipment (e.g. the video cassette recorder), which is personal equipment and personal recording media (e.g. the video cassette).

Brenner'068 further describes using the interactive wagering application to allow the user to access the personal archive at the head end or at the user equipment and view

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previously recorded races in cols. 7:4-20, 17:48-18:14, 21:63-22:12, and 27:23-29. See also local mass storage device 578 (FIG. 3).

Regarding claims 8-9, Brenner '068 teaches listing previously recorded races in the personal archive with their corresponding track name and race number (see at least figs. 49-50 and descriptions thereof).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brenner '068. Brenner '068 teaches the interactive wagering system substantially as described above. Brenner '068 lacks in specifically disclosing that previously recorded races in the personal archive are listed with their corresponding date. As described in Brenner '068, players place wagers on specific races, which requires that the player be able to correctly identify the results of a given race, for example in order to select from a list a previously recorded race upon which a player has placed a wager. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide date information with previously recorded races in order to allow users to correctly identify when the race took place. See at least figs. 49-50 and descriptions thereof.

Response to Arguments

13. Applicant's arguments contained in an appeal brief filed 7/19/2006 regarding prior art rejections have been fully considered to but are not persuasive. To the extent that the arguments set forth by the applicant could still be applicable in view of the new grounds of rejection, the arguments have been answered in the rejections above.

14. Applicant's arguments contained in an appeal brief filed 7/19/2006 regarding double patenting rejections have been considered to the extent that they are still applicable in view of the new grounds of rejection, but are not persuasive. MPEP 804 requires the examiner to raise double patenting issues when applicant's claimed invention conflicts with an existing patent *as claimed*. Chart II-B (MPEP 804) indicates that a double patenting rejection in this instance is proper. Specifically, a double patenting rejection is proper when the claims conflict between an application and a patent, and: the inventions are not patentably distinct, the application and patent are currently owned but have different inventive entities, and there is no showing of common ownership at the time of applicant's invention or no joint research exclusion under 103(c) applies. Note that the chart allows both prior art rejections *and* obviousness-type double patenting rejections. Therefore, applicant's argument that Brenner '211 is prior art under 102(a) and therefore not available for double patenting is incorrect. The examiner further notes MPEP 804.03(IV), which indicates that the examiner should make "(A) any appropriate double patenting rejection(s), and (B) the appropriate prior art rejection(s) under 35 U.S.C. 102 and/or 35 U.S.C. 103 in the application being examined."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch Jr. whose telephone number is 571-272-2818. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

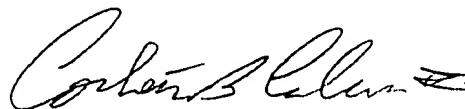
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



William H. McCulloch Jr.
Examiner
Art Unit 3714
1/21/2007



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CORBETT B. COBURN
PRIMARY EXAMINER

EVIDENCE APPENDIX C
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